

REMARKS

I. STATUS OF CLAIMS

Claims 1-17 and 19-99 are pending. Claims 2-16 and 96-98 are withdrawn from consideration for being drawn to non-elected subject matter. No claim is amended herein.

II. REJECTIONS UNDER 35 U.S.C. § 103

A. Hanna et al. (U.S. Patent No. 5,843,417)

Claims 1, 18-42, 49-52, 70-95 and 99¹ have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,843,417 to Hanna et al. ("Hanna"). Office Action at p. 5. Applicants submit that the claimed invention is not obvious in view of Hanna for the reasons of record as well as the additional reasons set forth below.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. M.P.E.P. § 2142. In *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q. 2d 1385 (2007), the Supreme Court confirmed that the "framework for applying the statutory language of §103" was still based on its landmark decision in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). Under *Graham*, there are four factors for consideration when determining whether an invention is obvious:

- (1) the scope and content of the prior art;

¹ We note that claim 18 is incorrectly listed here as a rejected claim, even though the Examiner has acknowledged its cancellation and has excluded it from the list of pending claims in the Office Action Summary.

- (2) the differences between the prior art and the claims at issue;
- (3) the level of ordinary skill in the art; and
- (4) secondary considerations.

383 U.S. at 17, 148 U.S.P.Q. at 467. The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. See 383 U.S. at 17-18, 148 U.S.P.Q. at 467.

In order to satisfy the initial burden of establishing a *prima facie* case of obviousness, the examiner must:

make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

M.P.E.P. § 2142. The key, moreover, "to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." *Id.* The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

Here, the Examiner has not established a *prima facie* case of obviousness because the claimed invention as a whole would not have been obvious in view of

Hanna. Independent claim 1 is directed to a foundation comprising, *inter alia*, at least one other surfactant chosen from dimethicone copolyols, wherein the at least one other surfactant chosen from dimethicone copolyols is present in an amount ranging from 5% to 10% by weight, relative to the total weight of the emulsion. As previously pointed out, Hanna does not disclose or suggest introducing the specific combination of at least one C₈-C₂₂ alkyl dimethicone copolyol (e.g., a cetyl dimethicone copolyol) and at least one other dimethicone copolyol as surfactants in a cosmetic composition, wherein the at least one other surfactant chosen from dimethicone copolyols is present in an amount ranging from 5% to 10% by weight, relative to the total weight of the emulsion.

At col. 4, lines 56-57, Hanna discloses that the disclosed compositions preferably comprise one or more surfactants. At col. 5, lines 3-7, Hanna mentions that the surfactant can be a “dimethicone copolyol, laurylmethicone copolyol, glyceryl stearate, beeswax, cetyl dimethicone copolyol, polyglyceryl-4-isostearate, hexyl laurate, etc.,” and that “mixtures of . . . surfactants may be used.” At col. 5, lines 29-31, Hanna discloses that the total amount of oil surfactant is from 5 to 15 wt%. However, there is no guidance in Hanna that, in addition to at least one C₈-C₂₂ alkyl dimethicone copolyol, another dimethicone copolyol is present in an amount ranging from 5% to 10% by weight as recited in claim 1. Accordingly, Applicants submit that the Examiner has failed to establish that the present claims are *prima facie* case of obviousness in view Hanna.

Additionally, Applicants submit herewith a Declaration under 37 C.F.R. § 1.132 (“Declaration”) executed by Ozée Emmanuelle, providing experiments that demonstrate the unexpected superiority of the claimed foundation. Based on the comparative data

provided in the Declaration, it is evident that, in accordance with the teachings in the specification at paragraph [006], the claimed foundation has unexpectedly superior homogeneity and stability as compared with compositions comprising an amount of dimethicone copolyol outside the 5-10% range recited in present claim 1. Specifically, the experiments provided in the Declaration compare a foundation composition of example 1 (an inventive example, comprising 5% by weight of dimethicone copolyol), with compositions A and B (comparative examples), which comprise 0.5% and 4% by weight of dimethicone copolyol, respectively. The stability of each composition was initially measured after 24 hours. The results revealed that the viscosity, and thus the stability of Example 1 was significantly higher than either of compositions A or B. In fact, it was determined that composition A was not stable after 24 hours at room temperature. After 2 months at room temperature, Example 1 and composition B were analyzed under a microscope to examine their homogeneity and stability. The results revealed that the composition of Example 1 is a homogeneous emulsion with very small droplets of water whereas the emulsion of composition B was not homogeneous and had large droplets of water.

For at least the foregoing reasons, Applicants submit that the Examiner failed to establish a *prima facie* case of obviousness based on Hanna. Moreover, Applicants presented sufficient evidence to rebut any *prima facie* showing. Accordingly, Applicants submit that the rejection of claims 1, 17, 19-42, 49-52, 70-95 and 99 under § 103 is improper and should be withdrawn.

B. Hanna in view of Elm et al. (U.S. Patent No. 4,552,753)

Claims 43-47 and 53-69 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hanna as applied to claims 1, 17-32, 38-42, 49-52, 70-93 and 99² above, and further in view of US Patent No. 4,552,753 to Elm et al. ("Elm"), and as evidenced by the Aldrich Catalog 2003-2004. Office Action at p. 8. Applicants respectfully disagree and traverse the rejection for the reasons of record and for the additional reasons discussed below.

As discussed above, Hanna fails to teach or suggest all the limitations of the present claims. Moreover, the Examiner concedes that Hanna does not teach the particular volatile linear and/or cyclic silicone oils of the presently rejected claims, nor the flash points of said volatile silicone oils. The Examiner relies on Elm to cure these additional admitted deficiencies. However, Elm does not and cannot cure the deficiencies of Hanna already set forth above, regardless of whether Elm teaches the elements asserted by the Examiner in such a way that one of skill in the art would be motivated to combine them, which Applicants do not admit Elm does. The Aldrich Catalog does not teach or suggest anything to rectify the deficiencies of Hanna and Elm either. Thus, the Examiner has not established a *prima facie* case of obviousness, and Applicants respectfully request that the Examiner withdraw this rejection.

² Again, Applicants point out that claim 18 is incorrectly listed here as a rejected claim, even though the Examiner has acknowledged its cancellation and has excluded it from the list of pending claims in the Office Action Summary.

C. Hanna in view of Bara et al. (U.S. Patent No. 6,224,851)

Claims 48-52 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hanna as applied to claims 1, 17-32, 38-42, 49-52, 70-93 and 99³ above, and further in view of U.S. Patent No. 6,224,851 B1 to Bara et al. ("Bara"). Office Action at p. 9. Applicants respectfully disagree and traverse the rejection for the reasons of record and for the additional reasons discussed below.

As discussed above, Hanna fails to teach or suggest all the limitations of the present claims. Moreover, the Examiner concedes that Hanna does not teach the particular volatile fluorinated oils of the presently rejected claims. The Examiner relies on Bara to cure this additional admitted deficiency. However, Bara does not and cannot cure the deficiencies of Hanna already set forth above, regardless of whether Bara teaches the particular volatile fluorinated oils of the presently rejected claims in such a way that one of skill in the art would be motivated to combine them with the compositions of Hanna, which Applicants do not admit Bara does. Thus, the Examiner has not established a *prima facie* case of obviousness, and Applicants respectfully request that the Examiner withdraw this rejection.

III. CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

³ Again, Applicants point out that claim 18 is incorrectly listed here as a rejected claim, even though the Examiner has acknowledged its cancellation and has excluded it from the list of pending claims in the Office Action Summary.

Please grant any extensions of time required to enter this response and charge
any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 8, 2008

By: Jennifer Leach
Jennifer R. Leach
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Attachment: Declaration under 37 C.F.R. § 1.132 executed by Ozée
Emmanuelle.